

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

The Examiner's indication of allowable subject matter of claims 17, 18, and 37 is noted with appreciation.

Claims 5-7, 9-10, 12-14, 16-26 and 29-44 are pending in the application. Allowable claims (17) and (18) have been rewritten in independent form in the manner kindly suggested by the Examiner in the Office Action. Independent claim 10 has been amended to avoid the Examiner's art rejections. Claims 41-44 have been added to provide Applicants with the scope of protection to which they are believed entitled. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 112, first paragraph rejection of claims 5-7, 9 and 21-26 is respectfully traversed because the application as filed clearly provides support for the claimed protective packaging sheet consisting of a single material layer. The Examiner states in page 2 of the Office Action that neither the specification nor the Figures show where the invention consists of only one layer. Applicants respectfully disagree.

Fig 1-2 - two layers; Fig 3-4 at least 2 layers

At the very least, FIGs. 1-4 clearly show a particular embodiment of the present invention that consists of one material layer. The specification in page 3, lines 30-32 discloses that "FIG. 1 is a plan view from above of a portion of the protective packaging sheet according to a particular embodiment of the present invention." Thus, FIG. 1 shows one embodiment of the present invention. FIGs. 2-4 are different views of the embodiment depicted in FIG. 1, as described in pages 3-4 of the specification. The Examiner's attention is now respectfully directed to the attached Exhibit A where corresponding parts of the plan view in FIG. 1 and the cross sectional views in *top view*

FIGs. 3-4 are designated with same reference lower case letters. A person of ordinary skill in the art, looking at FIGs. 1-4, would at once recognize that the portions (e.g., designated at b, e, i, m, p in Exhibit A), that are visible in FIGs. 3-4 but are not crosshatched, belong to the same material layer as the crosshatched portions (e.g., designated at a, c, d, g, h, k, l, n, o in Exhibit A). Thus, FIGs. 1-4 clearly show a particular embodiment of the present invention that consists of one material layer.

The specification also provides support for the invention of claim 5. In the section describing a method of producing the packaging sheet in accordance with the present invention (from page 7, line 17 to page 9 line 2), it has been disclosed that packaging sheet 1 of the present invention can be produced by heating and passing a thin sheet 20 of plastic material between rollers 22, 23 without having to laminate sheet 20 with any other material layer. The final product, i.e., sheet 1 in FIG. 5, can then be immediately used in its single layer form as described in page 9, lines 3-17 of the specification. Thus, a person of ordinary skill in the art would at once recognize that the sheet 1 produced by the process depicted in FIG. 5 is a particular embodiment of the present invention that consists of a single material layer as presently claimed in claim 5.

The Examiner's argument in the last sentences of paragraph 3 is noted. Page 3, lines 16-18 of the specification discloses only a preferred embodiment of the present invention. Note, "Preferably" at the beginning of the sentence in page 3, lines 16-18 of the specification. The scope of the disclosure of the present invention should not be limited to just that embodiment. The present invention has been adequately described to include other embodiments one of which consists of a single material layer as discussed in the two above paragraphs. Of particular note, the term "upper, middle and lower layers" are no longer presented in the claims.

Withdrawal of the 35 U.S.C. 112, *first paragraph* rejection in view of the above arguments is believed appropriate and therefore courteously solicited.

Indication of allowable subject matter of claims 9, 21, 25, 26 in the absence of applied art is respectfully requested.

The 35 U.S.C. 103(a) rejection of claims 5-7 and 22-24 as being unpatentable over *Roberts* (U.S. Patent No. 3,903,342) is traversed because *Roberts* fails to disclose, teach or suggest the limitation of independent claim 5 that the shaped protuberances being positioned in such a way that every straight line projected onto said sheet cuts through at least one of the shaped protuberances. — *embossed* Fig 5

The Examiner's interpretation of the above highlighted limitation in page 4 of the Office Action is noted. Applicants respectfully disagree with the Examiner's position, because the limitation positively recites the manner in which the shaped protuberances are arranged in the repeating pattern. — *dis, Fig 5 meets lim*

It appears that the Examiner considers the limitation a functional limitation and then disregards the limitation while comparing independent claim 5 with *Roberts*. If so, the Examiner is reminded that "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." MPEP, section 2173.05(g) (emphasis added). In the present case, the above-highlighted limitation fairly conveys to a person of ordinary skill in the art the manner in which the shaped protuberances are arranged in the repeating pattern, i.e., such that every straight line projected onto said sheet cuts through at least one of the shaped protuberances. The highlighted limitation sets definite boundaries on the patent protection sought and should not be disregarded.

Once the above highlighted limitation has been properly considered, rather than being disregarded, a person of ordinary skill in the art would envisage that *Roberts* lacks the claimed limitation. As can be seen in FIG. 5 of *Roberts*, straight lines extending along lines 75 do not cut

↓ *vert line would*

through any of the "protuberances" 79. See green lines in attached Exhibit B. The reference cannot be modified to include the claimed limitation, lacking a proper suggestion or motivation.

Independent claim 5 is thus patentable over *Roberts*. Claims 6-7 and 22-24 depend from claim 5, and are considered patentable at least for the reason advanced with respect to claim 5. Claims 6-7 and 22-24 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claims 22-23, *Roberts* fails to disclose, teach or suggest the claimed compression-strength. The Examiner argued that compression strength is an optimizable parameter and thus it would have been obvious to have modified the *Roberts* product to include the claimed compression strength. Applicants respectfully disagree.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), *MPEP*, section 2143.01.

Roberts relates to soft, absorbent unitary laminate like fibrous webs which is intended for use as towels and wipers. See the title and column 1, lines 10-11 of *Roberts*. Thus, if the *Roberts* product were modified to include the claimed compression strength, the modified product would be too hard to be regarded as soft and would be unsatisfactory for the intended purpose of being used as towels and wipers. Accordingly, even if the Examiner is correct that a person of ordinary skill in the art would have been motivated to have optimized the compression strength of the *Roberts* product, such a person of ordinary skill in the art would have modified *Roberts* only to an extent the modified product would still be satisfactory for the stated intended purpose. The person of ordinary skill in the art would not have made modifications that would have rendered *Roberts* unsatisfactory for the intended purpose, e.g., to include the claimed compression strength.

Thus, even if the compression strength of the *Roberts* product could be modified, it would not have been obvious to have modified *Roberts* to include the claimed strength of claims 22 and 23. Claims 22 and 23 are thus patentable over *Roberts*.

The 35 U.S.C. 103(a) rejection of claims 10, 12-14, 16, 19-20, 29-36 and 38-40 as being obvious over *Rudy* in view of *McGuire* is noted.

Independent claim 10 has been amended to avoid this rejection. Amended claim 10 now requires that the gaps between the shaped protuberances are **fully filled** with insulating foam. *McGuire* teaches only partially filling the gaps. See column 16, lines 30-31, 38-40 and FIG. 9 of *McGuire*. If *Rudy* were modified to include foam partially filled in the gaps as taught by *McGuire*, the modified product would still lack a planar face that extends substantially **throughout an entire area of said sheet**, as recited in claim 10. Amended claim 10 is thus patentable over the applied art of record.

Claims 12-14 and 16-20 depend from claim 10, and are considered patentable at least for the reason advanced with respect to amended claim 10. Claims 12-14 and 16-20 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claim 14, the applied art of record fails to disclose, teach or suggest the claimed **overfill** feature because *McGuire* teaches only partially filling the gaps. The Examiner did not specify where in the applied art the feature of claim 14 may be found or suggested.

Independent claim 29 remains unchanged notwithstanding the Examiner's rejection. Independent 29 is patentable because the applied art of record, especially *Rudy*, clearly fails to disclose, teach or suggest **connecting webs** connecting adjacent said shaped protuberances, said connecting webs being **located at a middle level between the tops of the shaped protuberances and the bottoms of the valleys**.

The Examiner's attention is respectfully directed to Exhibit C which shows several figures of *Rudy* and the manner in which the Examiner appears to read elements of *Rudy* on claim 29. Claim 29 requires that connecting webs be located at a middle level between the tops of the shaped protuberances and the bottoms of the valleys, i.e., at a level between top 103 (red ink) and bottom 105 (red ink). Such connecting webs are absent from the *Rudy* figures and are not disclosed or suggested elsewhere in the reference.

If the Examiner contends that *Rudy* discloses connecting webs at 106 (blue ink) or 105 (red ink), then it is unclear what element of *Rudy* would be considered as the claimed valley's bottom. (12)

Rudy and *McGuire* in combination clearly fail to disclose, teach or suggest all limitations of claim 29. The 35 U.S.C. 103(a) rejection of claim 29 and its dependent claims is erroneous and should be withdrawn.

The rejection of claims 38-39 depending from claim 5 is traversed because *Rudy* and *McGuire* singly or in combination fail to disclose, teach or suggest all limitations of the rejected claims, i.e., a packaging sheet, consisting of a single material layer as recited in claim 5.

New claims 41-44 are patentable at least for the reasons advanced with respect to claims 5 and 29 from which claims 41-44 depend. Claims 41-44 are also patentable on their own merits as will be apparent to the Examiner upon reviewing these claims.

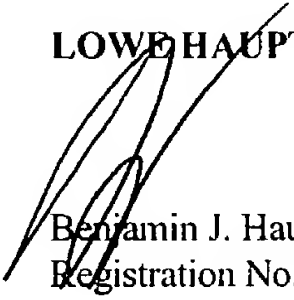
Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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